

**REMARKS**

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

**Status of the claims**

Claims 6, 8, 9 and 11-30 were pending in the subject application, of which claims 20-22, 25 and 28-30 were withdrawn from consideration by the Examiner. With this submission, claims 9, 18, 19 have been amended to incorporate the language of claim 16, thereby necessitating its cancellation. No claims have been newly added. Hence, upon entry of this submission, claims 6, 8, 9, 11-15, and 17-30 will remain pending, of which claims 6, 8, 9, 11-15, 17-19, 23, 24, 26 and 27 will be under active consideration.

**Priority**

The instant application has been granted the benefit date of 25 June 2004, which is the filing date of PCT/JP04/09386, to which the application claims benefit. However, the Examiner has not granted the application the benefit date of Japanese application no. 2003-432329 filed 26 December 2003, to which the application also claims benefit, because a certified copy of the priority document has not been received by the Office.

Applicants have submitted with this Response a certified copy of Japanese priority application no. 2003-432329. Hence, Applicants respectfully request that the present application be granted a benefit date of 26 December 2003.

**Claim rejections under 35 U.S.C. § 112 first paragraph**

Applicants acknowledge, with thanks, the Examiner's withdrawal of the previous rejection of claim 17 under 35 U.S.C. § 112 first paragraph.

**Claim rejections under 35 U.S.C. § 102**

Mahmood

Claims 9, 11-15 and 17-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mahmood *et al.*, Neurosurgery, Vol. 49, No. 5, November 2001: 1196-1204 (“Mahmood”). Because the Examiner has interpreted “mesenchymal cells” of the present invention to encompass “marrow stromal cells” taught by Mahmood, the Examiner alleges that Mahmood anticipates the present invention. Applicants respectfully traverse the rejection.

The claims, as presently amended, recite the use of mesenchymal stem cells that are either (a) treated *ex vivo* with a transfection vector comprising a BDNF gene, PLGF gene, GDNF gene or IL-2 gene; or (b) immortalized by treatment *ex vivo* with a transfection vector comprising an hTERT gene. Mahmood is silent with respect to (a) and (b).

Hence, insofar as a reference must teach each and every element of a claimed invention in order to be anticipating, Mahmood cannot sustain a rejection of the present claims under Section 102. Hence, Applicants respectfully request the withdrawal of this rejection.

Gold

Applicants thank the Examiner for withdrawing the rejection of claims 6 and 8 under 35 U.S.C. § 102(b) as allegedly anticipated by US publication no. 2002/0168766 to Gold *et al.* (“Gold”).

Kazuhiko

Claims 6-9, 11-13, 15-19, 23-24 and 26-27 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Kazuhiko *et al.*, Molecular Therapy, Feb. 2004. 9(2): 189-197 (“Kazuhiko”). As noted above, the present application should properly be granted the benefit of Japanese priority application no. 2003-432329, which antedates Kazuhiko. With the present submission of a certified copy of the priority application, Applicants believe that all

of the requirements under 35 U.S.C. § 119 (a)-(d) have been met. Accordingly, Kazuhiko is not "prior art," and withdrawal of the rejections based on same reference is respectfully requested.

### **Conclusion**

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,



By \_\_\_\_\_

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